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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,993	05/06/2002	Fridjof Gobel	5661-01-DRK	9881

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Crowell & Moring  
PO Box 14300  
Washington, DC 20044-4300

EXAMINER

SEAMAN, D MARGARET M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/019,993

Applicant(s)

GOBEL ET AL.

Examiner

D. Margaret Seaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16-23 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-11, 13 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 14, 16-23 and 27-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14, 16-23 and 27-32 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This application was filed 6 May 2002 and is a 371 of PCT/GB00/01788, filed 10 May 2000. Claims 1-14, 16-23 and 27-32 are before the Examiner.

#### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 5, 6, 12, 14, 16-18, and 21-23 (specifically) and claims 1-4 and 29-32 (generically), drawn to compounds wherein R4 is formulas 1, 2, 3 or 10 and R2 and R3 do not combine to make a ring.

Group II, claim(s) 19 (specifically) and claims 1, 2 and 29-32 (generically), drawn to compounds wherein R4 is formulas 1, 2, 3 or 10 and R2 and R3 make a ring.

Group III, claim(s) 7, 10 and 13 (Specifically) and claims 1-4 and 29-32 (generically), drawn to compounds wherein R4 is formulas 4, 5 or 6.

Group IV, claim(s) 8, 9 and 11 (specifically) and claims 1-4 and 30-32 (generically), drawn to compounds wherein R4 is of formulas 7, 8 or 9.

Claim 20 has not been included in the above lack of unity of invention due to the claim being unclear as to what is contained within the claim. Claims 27 and 28 have not been included in the above lack of unity of invention due to these being dependent from canceled method claim 26. These claims appear to apply in part to all the above groups I-IV.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

corresponding special technical features for the following reasons: there is no common core that leads to the inventive step of the instant claims. The common core is C(O)-N. This is not applicant's contribution to the instant art.

3. During a telephone conversation with David Kurlandsky on 24 February 2003, a provisional election was made with traverse to prosecute the invention of I, claims 5, 6, 12, 14, 16-18 and 21-23 (specifically). Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-11, 13 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 12, 14, 16-18, 21-23, and 29-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zeile (US Patent #3,101,339), Nadelson (US Patent #4,681,898), Bock (US Patent #5,464,788, CA 123:330860), Dombro (CA 60:93472, 63:35608), Diurno (CA 122:230112), Sekiya (CA 113:190946, JP 02138161) and Sandoz (EP 0084292).

Zeile discloses compounds such as RN 10507-26-3 that anticipate the instantly claimed compounds, compositions and use as CNS agents. Nadelson discloses compounds and their use as pharmaceuticals for compounds such as RN 88098-99-1. Bock discloses compounds such as RN 170930-07-1 and its use as a pharmaceutical. Dombro discloses compounds such as RN 10231-08-0 and RN 3115-15-9 that are used as pharmaceuticals. Diurno discloses RN 162321-78-0 for use as pharmaceuticals. Sekiya discloses compounds such as RN 129989-57-7 used as a pharmaceutical. Sandoz

discloses many compounds within the scope of claim 1 (see abstract) that are used as pharmaceuticals.

*Claim Rejections - 35 USC § 112*

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 20, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what claim 20 is trying to claim. Claims 27 and 28 are dependent from a now canceled claim 26. Clarification and correction is required.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 703-308-4528. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for


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the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
D. Margaret Seaman  
Primary Examiner  
Art Unit 1625

dms  
March 4, 2003